TM TTAB

Docket No. 740120-179

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application No. 75/936,519
Published On: November 21, 2000

PUMA AG RUDOLF DASSLER SPORT	)	
Opposer	)	
v.	)	Opposition No. 123,141
MOURAD, SAMIR DBA DON REGALON	)	
Applicant.	)	

OPPOSER'S MEMORANDUM IN REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

Pursuant to 37 CFR 2.127(a) Opposer respectfully submits a memorandum in reply to Applicant's Opposition to Opposer's Motion For Leave to Amend Notice of Opposition and requests that the Board exercise its discretion to consider this memorandum.

The Motion for Leave to Amend Should be Granted Where the Amended Notice of Opposition is Legally Sufficient and There is no Prejudice to Applicant

In practice, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party. *See,* TBMP §507.02 and cases cited. Whether an adverse party will be prejudiced by the amendment is largely dependent on the timing of the motion to amend. Where the Board proceeding is still in the pre-trial stage (i.e., in discovery or prior to plaintiff's testimony), generally there will be no prejudice to the adverse party as that party will have full opportunity for discovery on the matters raised in the amended pleading.

Moreover, the interests of justice and judicial economy will best be served by entry of the proposed amendment.

Nevertheless, Applicant has asserted that the motion for leave to amend should be denied, *inter alia*, "because it is without merit and is unfair," "is frivolous and unfounded," because Opposer "has unreasonably delayed" prior to filing the amended Notice of Opposition and because Applicant will be unduly prejudiced if Opposer is permitted to amend. These assertions are without merit, as will become apparent from the discussion which follows.

The Proposed Amendments Are Timely, Do Not Increase Applicant's Burden and Provide Fair Notice to Applicant

When the Notice of Opposition was originally filed, its focus was to assert Opposer's famous leaping cat silhouette trademarks (see Paragraphs 1-3). To this end Opposer specifically asserted two of its registrations and alleged that it had used the leaping cat silhouette "either alone or in combination with other words and/or designs" since prior to the filing of the opposed application. Opposer also asserted that such use has been continuous up to the present. Opposer has, over the many years since first use of the present leaping cat silhouette in about 1968, used the silhouette mark in combination with numerous other words and designs. Therefore, at the time of filing the Notice of Opposition, due to the overwhelmingly extensive use of its famous leaping cat silhouette trademarks, Opposer based its opposition thereon. Because there were thousands of pages of catalogs and marketing materials in its files, Opposer was unable to assemble and search all of these materials in sufficient detail to identify each and every use of the leaping cat silhouette mark, particularly relatively minor usages in terms of time or sales, even in the extended time period prior to filing the Notice of Opposition. It was not until Opposer's counsel, in response to Applicant's numerous requests to produce thousands of pages of documents, reviewed the catalog pages that it was appreciated that Opposer had used as a trademark for clothing a cat silhouette leaping through the letter "D". At a subsequent time, it was discovered that another and different cat silhouette leaping through the letter "P" had also been used as a trademark for clothing. Because these usages were believed to be particularly relevant to Applicant's efforts to register the silhouette of a cat leaping through the letter "V", in order to provide Applicant with prompt notice of Opposer's intent to assert these usages during

the opposition proceeding, both of these marks were brought to the attention of Applicant's counsel within a few weeks of discovering their prior usage. Applicant, subsequently, filed its motion for leave to amend during the discovery period and within a very short time after Applicant's counsel refused to stipulate to amending the Notice of Opposition. Therefore, Opposer was at all times diligent and timely in giving notice to Applicant and in filing the instant motion for leave to amend.

Even the most cursory reading of Paragraphs 4 and 5 of the amended Notice will make clear that the proposed amendments to the Notice of Opposition are not for the purpose of asserting a new claim or defense or curing a defective pleading. Rather, their purpose is to amplify allegations already set forth in the original Notice, paragraph 3, and to provide additional evidentiary details. This is one of the several purposes of amendments under Rule 15(a) FRCP. *See, U.S. Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993); Beth A. Chapman, TIPS FROM THE TTAB: *Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302, 303-304 (1991). As a result, the basis of the claim asserted in the Notice of Opposition under Section 2(d) remains unchanged and granting of the motion for leave to amend, therefore, would impose no meaningful additional burden on Applicant.

The Proposed Amended Notice of Opposition is Legally Sufficient to State a Claim Under Section 2(d)

In deciding a motion to amend under FRCP 15(a) the Board must consider whether the amended pleading is legally sufficient. This does not, of course, mean that the Board should assess the factual merits of the amended pleadings at the time the amendment is sought, as Applicant asks the Board to do. Applicant's detailed substantive arguments going to the merits of Opposer's proposed amendments are inappropriate at this stage and should not be considered in determining whether Opposer is permitted to amend its notice of opposition. *See, Dynachem Corporation v. The Dexter Corporation,* 203 USPQ 218, 220 (TTAB 1979). Rather, the Board need only examine the allegations to determine whether the proposed Notice is legally sufficient, which means that Opposer need only allege in its notice of opposition facts which, if proved, would be sufficient to state a claim under Section 2(d). Whether Opposer can actually prove the claim is a matter to be determined after the introduction of evidence and not on this

motion for leave to amend. *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha,* 22 USPQ2d 1316, 1318 (TTAB 1992).

Opposer has added Paragraphs 4 and 5 to the Notice of Opposition. In Paragraph 4, Opposer alleges that prior to Applicant's filing date it adopted and used a design trademark comprised of the letter "D" with cat silhouette leaping through the letter "D" for clothing. Inasmuch as Applicant seeks to register a design trademark comprised of the letter "V' with cat silhouette leaping through the letter "V" for clothing, for purposes of this motion to amend, it is clear beyond doubt that Opposer's allegations are relevant and state a legally sufficient claim under Section 2(d), particularly in view of the other allegations in the Notice of Opposition.

In Paragraph 5, Opposer alleges that at least as early as June, 2001, Opposer adopted and used a design trademark comprised of the letter "P" with cat silhouette leaping through the letter "P" for clothing. Applicant argues that such usage took place after its filing date and that Opposer contrived the "P" mark in bad faith to further harm and damage Applicant. Notwithstanding Applicant's untrue, unsubstantiated and reckless statements regarding bad faith, Opposer's allegations must be accepted as true and the Notice of Opposition must be viewed in a light most favorable to Opposer. *See, Space Base, Inc. v. Stadis Corp.,* 17 USPQ2d 1216 (TTAB 1990). The cat silhouette is identical to the cat silhouette mark ("old" version) shown in Opposer's pleaded registrations and which has been in use by Opposer for several decades. The more current version of the mark pleaded in Paragraph 5 ("new" version) differs from the "old" version only in that the cat silhouette is leaping through the letter "P". Thus, the leaping cat silhouette is the continuing common element of the mark, presenting a single and continuing commercial impression such that consumers would regard the old and new versions of the mark as essentially the same. Trademark rights inure in the basic commercial impression created by a mark and not in any particular form or style. *Humble Oil & Refining Co. v. Sekisui Chemical Co.,* 165 USPQ 597, 603-604 (TTAB 1970). *See, 2* McCarthy on Trademarks, §17:26 (4th Ed. 2002). Thus, the early priority to which the old version is entitled attaches to the new version. If this were not so a trademark owner would be discouraged from altering its mark in response to consumer preferences or new advertising or marketing styles. *Humble Oil, ibid.* Accordingly, Paragraph 5, together with the other allegations of the Notice of Opposition, state a legally sufficient claim.

Apart from the separate merits of the allegations of newly added Paragraphs 4 and 5, the proposed amendments to the Notice of Opposition are for the purpose of amplifying allegations already set forth in Paragraph 3 of the original Notice of Opposition, i.e., they add evidentiary detail but do not diminish in any way the sufficiency of the original allegations. As evidenced by the fact that Applicant has not questioned the sufficiency of the original allegations by way of a motion to dismiss for failure to state a claim, the original Notice was clearly sufficient. It follows that the amended Notice is at least equally sufficient in terms of stating a claim under Section 2(d). Applicant's emotional posturing, to the extent it is relevant at all, goes to the merits of the allegations but not to their sufficiency to state a claim. This is not the time for the Board to get bogged down in the merits of the case. Accordingly, the motion for leave to amend and the amended Notice are legally sufficient and, if the Applicant is not unduly prejudiced, the motion should be granted.

Applicant Will Not Be Prejudiced by Granting Opposer's Motion for Leave to Amend

The question of whether Applicant will be prejudiced by allowance of the amended Notice of Opposition is largely dependent on the timing of the motion to amend. Historically, if the Board's proceeding is still in the pre-trial stage, as it was in the instant case when the motion for leave to amend was filed, or at least at a stage prior to any testimony having been taken in plaintiff's testimony period, leave to amend will be allowed. *See,* TBMP §507.02 and cases cited. This is because if discovery is still open, or can reasonably be reopened prior to trial, there is no prejudice to Applicant which is cognizable by the Board in an opposition proceeding. Applicant will have a full opportunity for discovery on the matters raised in the amended Notice. The fact that the Applicant may be inconvenienced as a result of delay to the proceedings or the need to prepare some additional discovery, or that granting of the motion may cause Applicant to incur additional costs, does not rise to the level of cognizable prejudice sufficient to defeat a motion to amend.

In the present instance, Opposer filed its motion for leave to amend in a diligent and timely manner shortly after it learned of the facts leading to the proposed amendment. The motion was filed during the discovery period and Opposer requested an additional month of discovery to allow Applicant the time it might need to pursue discovery relating to the amended

Notice. On substantially similar facts in *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha,* 26 USPQ2d 1503 (TTAB 1993), the Board held that applicant would not be prejudiced by allowance of a new claim since opposer had indicated its agreement to allow applicant further time to conduct any follow up discovery with respect to the new claim. Applicant in the instant proceeding will be afforded the very same opportunity and, accordingly, it too will not be prejudiced by granting of the motion.

The Motion Should Be Granted

In view of the foregoing, because Opposer's motion was diligently and timely filed during the discovery period, the discovery period remains open or can readily be reopened and the amended Notice of Opposition is legally sufficient to state a claim under Section 2(d), the motion for leave to amend should be granted and the discovery period extended for an additional time, e.g., one month, for the specific and exclusive purpose of allowing Applicant to conduct whatever discovery it desires on the new allegations in the Notice.

Respectfully Submitted,

PUMA AG RUDOLF DASSLER SPORT

Dated: 08-26-02

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing:

Opposer's Memorandum in Reply to Applicant's Opposition to Opposer's Motion for Leave to Amend Notice of Opposition;

was mailed by first class mail, postage prepaid, on August 26, 2002 to:

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